UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,646	01/25/2002	Harry R. Davis	CV01379K	3480

24265 7590 06/06/2006

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH, NJ 07033-0530

EXAMINER	
WANG, SHENGJUN	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/057,646	DAVIS ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-30 and 32* is/are pending in the application.

4a) Of the above claim(s) *11-27,29 and 30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-10,28,32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted March 15, 2006 is acknowledged.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-4, 7-10, 28, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenblum et al. (US 5,846,966, IDS), in view of Kim (US 5,698,527, IDS) and Keller et al (WO 00/38725, IDS).

3. Rosenblum teaches the instant cholesterol absorption inhibitors and its application for lowering serum cholesterol. Rosenblun further teaches that the cholesterol absorption inhibitors may be employ in combination with other cholesterol lowering agents, such as simvastatin. See, particularly, the abstract, and the claims. Rosenblum et al. teach that daily dosage of the compounds is about 5mg to 1000 mg, given in a single dose or 2-4 divided doses. When used in combination with other drug the dose is about 1mg to 1000 mg a dose given 1 or 2 times a day. The exact dose would depend on various conditions. See, particularly, col. 21, lines 17-63.

4. Rosenblun et al. do not teach expressly a combination of the cholesterol absorption inhibitor and nicotinic acid.

5. However, Kim teaches that nicotinic acid (niacin) is a well-known cholesterol lowering agents, and is particularly useful in combination with cholesterol absorption inhibitors. See, particularly, the abstract, and column 32, lines 9-25. Keller et al. teaches various combinations of cholesterol lowering agents, including ezetimibe and nicotinic acid, for treating hypercholesterolemia-associated disorders. See, particularly, the abstract, and pages 11-14.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition comprising ezatimibe and nicotinic acid, and optionally simvastatin.

A person of ordinary skill in the art would have been motivated to make a composition comprising ezatimibe and nicotinic acid, and optionally simvastatin because it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known cholesterol lowering sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. Further, the prior art have suggested the usefulness of combination of different cholesterol lowering agents, particularly, cholesterol absorption inhibitor and nicotinic acid. As to the specific amount of ezatimibe, note the amount (10 mg) is within the range disclosed by Rosenblum et al. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Further, Optimization Within Prior Art Conditions or Through Routine Experimentation Generally, differences in concentration or

temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Response to the Arguments

Applicants' amendments and remarks submitted March 115, 2006 have been fully considered, but are not persuasive with respect to the rejections set forth above.

Applicants' arguments fail to reach the instant rejections core issue; that concomitantly employing compounds, old and well known for the same use is obvious to the skilled artisan. To overcome this rejection Applicants must illustrate the presence of unexpected benefits in the resulting mixture. Any combination not shown to possesses such unexpected benefits must remain properly rejected as obvious. In illustrating unexpected therapeutic benefits the Applicant must test all active components individually to ensure a greater than additive therapeutic benefit. Further, the art have shown that it is a common practice for combining different therapeutical agents for treating patient with hyperlipidemia and hypercholesterolemia as reasonable expectation of additive or synergistic effect. Niacin is particularly disclosed as useful with in combination with cholesterol absorption inhibitors. Considering the cited references as a whole, one of ordinary skill in the art would have view the combination of ezatimibe (a known cholesterol absorption inhibitor) and niacin as obvious since both are known as cholesterol lowing agents and are known to be suitable for using together (see Keller et al.).

The arguments of commercial success are deemed unpersuasive. Note the success commercial product is ZETIA™ (ezetimibe), note the claimed combination.

a. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. This application contains claims 29 and 30 drawn to an invention nonelected with traverse in Paper No. 10, filed August 15, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
Art Unit 1617